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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,723	11/15/2001	David A. Farber	P 283002 TN-Cont-2	7771

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WASHINGTON, DC 20006

EXAMINER
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HOMERE, JEAN RAYMOND

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 12/01/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/987,723

Applicant(s)

FARBER ET AL.

Examiner

Jean R. Homere

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-- The MAILING DATE of this c mmunicati n appears on the cover sheet with the correspondence address --

**Peri d for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 54-109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,8,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 09/03/03, 11/15/01 comply with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.
2. The 10 page IDS filed on 07/29/03 contains the same references cited in the IDS filed on 11/15/01. Accordingly, the information referred to therein has not been considered by the examiner. See attached IDS.

### **Related Applications**

3. Applicants are advised to provide the serial numbers and corresponding statuses of all patent applications referenced at pages 1 of this application.

### **Drawings**

4. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Specification***

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The abstract of the disclosure is objected to because it contains legal phraseologies (e.g. "comprising"). Correction is required. See MPEP § 608.01(b).

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Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 54-109 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of U.S. Patent No. 6,415,280. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 54-109 do not recite the limitation of whereby at least some of the files being cached versions of files from a source server distinct from the

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network of servers. It would have been obvious to one of ordinary skill in the art to modify the claims of the present application to achieve the delivery of the content of a file on the distributed network without having to use cache versions of some of the files. Such modification would simplify the delivery process of the files in question. Further, it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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9. Claims 54, 56-58, 62-64, 66-94, 96-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al. (Nelson), US. Patent No. 5,452,447, in view of Hamilton et al. (Hamilton), US Patent No. 5,640,564.

As to independent claims 54, 56-58, 62-64, 70, 74, 75, 83, 84, 92, 96, 98, 102-105, 107, Nelson substantially discloses the invention including a data processing system for caching a file server to thereby allow client users to request and retrieve files in a distributed computer system (abstract, lines 1-8 et seq.) In particular, Nelson discloses the use of a hash function on a data file to thereby quickly retrieve a copy of the data file from the cache upon user's request (col.17, lines 18-41 et seq.)

Nelson does not particularly detail the use of the hashing function on the data file to create an identifier, which can be utilized to retrieve the data file upon user's request. However, Hamilton discloses an analogous system wherein a hashing function is applied to a data item to thereby create an identifier, which a user can utilize to request and retrieve a corresponding data item (col. 6, lines 28-39 et seq.) It would have been obvious to one of ordinary skill in the art of data processing to combine the teachings of the cited references because Hamilton's teaching would allow the users of Nelson's system to expeditiously and dynamically retrieve a file as it is being updated.

As to claims 66-67, 69, 71-73, Nelson teaches a security system to provide access to requested files to authorized users only (col. 18, lines 33-46 et seq.)

As to claim 68, Nelson discloses the retrieval of a data item from another server, if it is not located on a given server (col. 15, lines 23-26; col. 15, lines 50-60 et seq.)

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As to claim 79, Nelson teaches a substantially unique value of the data file (col. 17, lines 20-41 et seq.)

As to claims 80- 81, Nelson discloses that a plurality of data files can be distributed across the network as cached version of another server (col. 7, lines 29-35 et seq.)

As to claim 82, Nelson teaches that the name of the file will change when the file is modified (col. 22, lines 26-52 et seq.)

10. The limitations of claims 76-78, 85-91, 93-94, 97, 99, 100, 101, 106, 108, 109 have already been discussed in the rejection of claims 54, 56-58, 62-64, 66-75, 79-84, 92, 96, 98, 102-105, and 107 above . They are therefore rejected on similar grounds.

11. Claims 55, 59-61, 65 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al. (Nelson), US. Patent No. 5,452,447, in view of Hamilton et al. (Hamilton), US Patent No. 5,640,564, further in view of Peter Deutsch ("Deutsch"), "Re: MD5 and LIFNS (was: Misc Comments)", supplied by applicants in IDS, paper no. 9.

As to claims 55, 59-61, 65 and 95, Nelson substantially discloses the invention including a data processing system for caching a file server to thereby allow client users to request and retrieve files in a distributed computer system (abstract, lines 1-8 et seq.) In particular, Nelson discloses the use of a hash function on a data file to thereby quickly

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retrieve a copy of the data file from the cache upon user's request (col.17, lines 18-41 et seq.)

Nelson does not particularly detail the use of the hashing function on the data file to create an identifier, which can be utilized to retrieve the data file upon user's request. However, Hamilton discloses an analogous system wherein a hashing function is applied to a data item to thereby create an identifier, which a user can utilize to request and retrieve a corresponding data item (col. 6, lines 28-39 et seq.) It would have been obvious to one of ordinary skill in the art of data processing to combine the teachings of the cited references because Hamilton's teaching would allow the users of Nelson's system to expeditiously and dynamically retrieve a file as it is updated.

Nelson and Hamilton do not particularly teach that the use of an MD5 function to determine the name of a file. Deutsch, however, discloses that the use of MD5 is a suitable mechanism for determining a URN to thereby index said URN in the MD5 digest. It would have been obvious to one of ordinary skill in the art of data processing to combine the teachings of the cited references. Deutsch's teaching would provide users of the Nelson-Hamilton's system with an indexed name files stored in a digest to thereby quickly retrieve a requested file therefrom.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.



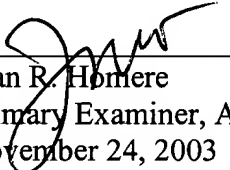
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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean R. Homer whose telephone number is (703)-308-6647. The examiner can normally be reached on Monday-Friday from 09:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breen, can be reached on Monday-Friday from 8:00 a.m. to 3:30 p.m. at (703)-305-9790.

**Any response to this action should be mailed to:** Commissioner of Patents and Trademarks Washington, D.C. 20231, **or faxed to:** (703) 872-9306. Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
\_\_\_\_\_  
Jean R. Homer  
Primary Examiner, A.U. 2177  
November 24, 2003